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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PICKETT, JOHN G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,836

Applicant(s)

KNAACK ET AL.

Examiner

Greg Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 29 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office action acknowledges the applicant's Amendment B, presented as Paper No. 5. Claims 1 and 3-8 are pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The proposed drawing corrections were received on July 29, 2003. These drawings are acceptable.

Specification

4. In light of the applicant's amendment, the objection to the abstract is hereby withdrawn.

5. In light of the applicant's amendment, the objection to the claims is hereby withdrawn.

Claim Rejections - 35 USC § 112

6. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, the terms "a flap (xx)" and "the flap (xx)" in lines 4, 11, 20, 22, 34, and 36 renders the claim indefinite since reference characters instead of terminology are used to define structure and locational relationships. The use of reference characters is to be considered as having no effect on the scope of the claims. See MPEP § 608.01(m).

Claim Rejections - 35 USC § 102

7. In light of the applicant's amendment, the rejection of claim 1 under 35 U.S.C. 102(b) is hereby withdrawn.

Claim Rejections - 35 USC § 103

8. Claims 1, 3, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (GB 853,891) in view of Stracke (DE 94 19 312.6).

Regarding claim 1, Smith discloses (Figures 1-3) a folding box having a rectangular pack casing (as shown, Figures 2 and 3) formed by the following:

- a front side wall (2) having a base end and a lid end;
- a rear side wall (4) having a base end and a lid end;
- a right-hand side wall (3) connecting front side wall (2) and rear side wall (4);
- a left-hand side wall (1) having a base end and a lid end;

intermediate flaps (5, 6, 7, 8), each having the same height, articulated on the base end of each of the side walls (1, 2, 3, 4);

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four base flaps (9, 10, 11, 12), each base flap articulated on each intermediate flap (5, 6, 7, 8), wherein the base flaps are adhesively bonded to one another such that the base automatically closes as the folding box is erected (Page 1, Lines 76-85);

and a top closure formed by three closure flaps (22, 23, 24) extending from the lid ends of the left-hand side wall (1), the right-hand side wall (3), and the rear side wall (4), the closure flap (22, 23) extending from the lid end of the rear side wall comprising a rectangular lid part (22) and an insertion flap (23). Smith also discloses a top support structure (20, 21).

Smith does not disclose closure flaps extending from the lid ends of the left and right hand side walls each having three folding lines which subdivide into a first spacer crosspiece, a supporting strip, a second spacer crosspiece, and an adhesive flap, with the adhesive flaps of the closure flaps bonded to the inside of the box so that the supporting strips are essentially at right angles to the spacer crosspieces

Stracke discloses a folding box (Figure 1) with articulated flaps (11) located on the top portion of the left-hand (4) and right-hand (5) side walls with four panels connected by three parallel fold lines (as shown, Figure 1). The flaps of Stracke function as claimed by the applicant. The flap structure of Stracke is an art recognized equivalent to the top support (21) of Smith for holding an end structure of an article within an enclosed box. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the top flaps (20, 21, and 24) of Smith with the top flaps (11) of Stracke since the selection of either of these known equivalents to retain the top portion of an article would be within the level of ordinary skill in the art.

As to claim 3, the folding box of Smith-Stracke discloses second and third articulated panels with a cutout (Stracke 16) for accommodating the product.

Regarding claim 7, Smith-Stracke discloses a box as applied to claim 1. Smith-Stracke meets all limitations claimed by the applicant except:

Smith-Stracke does not expressly disclose a box containing a jar with a screw closure positioned thereon.

Smith-Stracke is capable of containing a large variety of objects of a cylindrical nature, which are to be held at their top and bottom. Jars with screw closures are typically cylindrical in nature. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place a jar with a screw closure into the box of Smith-Stracke in the manner claimed by the applicant in order to securely transport a jar while preventing the spillage of its contents.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith-Stracke as applied to claim 1 above, and further in view of Lo Duca (US 5,540,330).

Smith-Stracke discloses a box as applied to claim 1. Smith-Stracke meets all limitations claimed by the applicant except:

Smith-Stracke does not disclose articulated flaps located on the top portion of the left-hand and right-and sidewalls with six panels connected by five parallel fold lines.

Lo Duca discloses a box (Figure 1, rotated 180°) with articulated flaps (9, 10) located on the top portion of the second (3) and fourth (1) sidewall with at least six panels connected by five parallel fold lines (as shown, Figure 1). The articulated flaps

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of Lo Duca are capable of folding as claimed by the applicant and are an art recognized equivalent structure to either the top structure of Smith (20, 21) or the end structure of Stracke (11) for holding an end of an article within an enclosed box. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the top flaps (20, 21, and 24) of Smith with either the flaps (11) of Stracke or the flaps (9, 10) of Lo Duca, since the selection of any of these known equivalents to retain the end portion of an article would be within the level of ordinary skill in the art.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith-Stracke as applied to claim 1 above, and further in view of Hobbs (US 2,979,250).

Smith-Stracke discloses a box as applied to claim 1. Smith-Stracke meets all limitations claimed by the applicant except:

Smith-Stracke does not disclose at least two of the four sidewalls tapering slightly in the direction of the lid region.

Hobbs discloses a box (Figure 1) with sidewalls (9) tapering slightly towards the lid region. Hobbs teaches this tapering to facilitate stacking (see for example Figure 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the box of Smith-Stracke with tapered sidewalls as taught by Hobbs in order to provide for secure stacking of the boxes.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith-Stracke as applied to claim 1 above, and further in view of Sparks (US 2,744,622).

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Smith-Stracke discloses a box as applied to claim 1. Stracke further discloses a box (Figure 1) with cutout (9) on front sidewall (3) extending into adjacent sidewalls (4, 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the cutout taught by Stracke in the folding box of Smith-Stracke in order to display the box contents to the consumer.

The box of Smith-Stracke does not disclose a transparent film covering the cutout. Sparks discloses a box (Figure 1) with a cutout having a transparent film (37) covering the cutout. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the box of Smith-Stracke with a transparent film covering as taught by Sparks in order to protect the contents from damage while allowing for viewing by the consumer.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Hamilton (US 3,438,482).

Smith discloses a punched blank (Figure 1) having:

a front sidewall (2);

a rear sidewall (4) having a rectangular lid part (22) articulated via a folding line and an insertion flap (23) articulated to the lid part on one side, and an intermediate flap (8), which terminates with a folding line and a base flap (12) articulated on the intermediate flap (8);

a right-hand sidewall (3) connecting the front sidewall (2) and the rear sidewall (4) and having articulated on one end an intermediate flap (7) which terminates with a folding line and a base flap (11) articulated to the intermediate flap (7) via a folding line;

a left-hand sidewall (1) having articulated on one end an intermediate flap (5) which terminates with a folding line and a base flap (9) articulated to the intermediate flap (5) via a folding line;

a base closure formed by four base-closure tabs (9, 10, 11, 12);

a top closure formed by three top-closure tabs (22, 24);

with the front, rear, right, and left sidewalls each linked to one another via folding lines and arranged rectilinearly one behind the other in a row.

Smith also discloses a flap (19) on the rear sidewall used to assist in the completion of the box, and a top retaining structure (20, 21) used to retain an article by its end.

Smith does not disclose a flap (19) articulated on the left-hand sidewall or flaps on the top portion of the left and right-hand sidewalls divided by folding lines into five sections comprising a first spacer crosspiece, a crosspiece, a supporting strip, a second spacer crosspiece, and an adhesive flap.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to relocate the flap (19) of Smith from the rear sidewall to the left-hand sidewall since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70

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Hamilton discloses a folding box blank (Figure 1) with flaps (11) on the top portion of left and right sidewalls (3) divided by folding lines into five sections comprising a first spacer crosspiece (9), a crosspiece (13), a supporting strip (14), a second spacer crosspiece (16), and an adhesive flap (16). The flap structure of Hamilton is an art recognized equivalent to the top support (21) of Smith for holding an end structure of an article within an enclosed box. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the top flaps (20, 21, and 24) of Smith with the top flaps (11) of Hamilton since the selection of either of these known equivalents to retain the top portion of an article would be within the level of ordinary skill in the art.

Response to Arguments

13. In light of a different interpretation of the prior art of record, the examiner has changed the grounds of rejection. Accordingly, this Office Action is **NON-FINAL**.

14. The references of Smith, Stracke, Lo Duca, and Hamilton all disclose folding box end flaps with structures to retain an end of a held article and are considered art recognized equivalents. All four retention means are considered interchangeable since they all are capable of being collapsed to enable an item to pass and therefore would not interfere with the top loading feature of Smith.

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15. The applicant's arguments concerning the flaps (24) of Smith are incorrect in their assertion of the function of these flaps. Flaps (24) merely cover the end panel (21) prior to the closing of the lid panel (22). Contrary to the applicant's assertion, flaps (24) are not intended to fold down prior to the insertion of the article (see for example, Figure 3). The replacement of flaps (24) and end retainer (21) with the equivalent retaining structures of Lo Duca, Stracke, or Hamilton would in no way destroy the function of Smith.

16. In response to the applicant's argument that the boxes of Smith and Stracke are completely different in their uses and that no person would ever make the substitution of the Stracke flaps for the flaps of Smith, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the examiner asserts that both boxes are used for the transport of articles and both boxes form a means for retaining said article in a secure position within the box, and are therefore of the same field of endeavor. Along these lines of reasoning, Lo Duca and Hamilton are also in the same field of endeavor.

17. In response to applicant's argument that there is no suggestion to combine the references of Smith and Lo Duca, the examiner recognizes that obviousness can only

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be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion can be found in Smith, which discloses a means (21) to retain the top portion of the article (see Figure 3). Lo Duca discloses an art recognized equivalent for end retention of an article, as do Stracke and Hamilton.

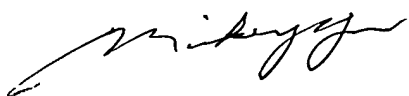
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Gregory Pickett
Examiner
October 2, 2003


Mickey Yu
Supervisory Patent Examiner
Group 3700